REMARKS

Claims 9-18, 27-35, and 51-66 have been withdrawn. Claims 1-8, 19-26, and 36-50 are pending in this application, including independent claims 1, 19 and 36. All claims have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,311,185 ("Markowitz") in view of U.S. Patent 6,286,005 ("Cannon") and what the Examiner characterizes as Applicants' admitted prior art. New claims 67-73 have been added by amendment in order to more fully protect Applicants' invention.

By way of background and illustration, claim 1 describes a method of placing graphical objects on a page, such as a webpage that is accessible by a user over the Internet. Each graphical object includes a link to information that can be invoked, such as by a user clicking on the link with a computer pointing device. In the method of claim 1, performance data associated with each object is stored, where the performance data may be used, for example, to calculate the likelihood that a user will click on the object (click-through percentage). The graphical objects are arranged on the page according to the performance data. Thus, for example, graphical objects can be arranged in descending order on a webpage according to click-through percentage (e.g., one embodiment of claims 2 and 4), or click-through percentage multiplied by a weighting factor such as a cost-per-click (e.g., one embodiment of claims 3, 6 and 7).

Applicants submit that Markowitz is not applicable. Markowitz is directed to a method and apparatus for modifying an information page transmitted to a client computer over a network such as the Internet. First, a request to display an information page is received from a client computer. A central server then obtains the requested page, selects additional data (such as an advertisement), modifies the requested page to include the additional data, and sends the modified page to the client computer for display to a user. (See, e.g., Abstract; col. 2, lines 21-29.)

The system of Markowitz also determines where the advertisement is to be incorporated into the requested page (e.g., Fig. 3; col. 4, lines 11-17). For example, if the original page has empty areas, advertisements can be positioned there; if the original page has no empty area, the page can be modified so that space is created for an advertisement (e.g., Fig. 4; col. 4, lines 20-33.)

However, Markowitz does not describe or suggest arranging objects on a page according to stored performance data for the respective objects, as recited for example in Applicants' claim 1. Markowitz does not even recognize the issue of how to arrange multiple advertisements relative to one another on a webpage. The Examiner's assertion to the contrary appears to be based on a misinterpretation of Markowitz. The "history database 210" in Markowitz may be used to help select an advertisement, but it is not used to position or prioritize advertisements relative to one another on the requested page.

Thus, Markowitz is completely silent on at least one key feature of Applicants' claim 1 ("arranging the objects on the page according to the performance data"), independent claim 19 ("prioritizing objects on a page according to the [past performance] data"), and independent claim 36 ("objects are arranged on the page using the calculated values" indicative of the rate that a specified event occurs for each graphical object displayed to the user). This feature is also found (in more detail) in new independent claim 67 ("objects are arranged using the product of the click-through percentage and the cost-per-click").

Cannon does not cure this deficiency of Markowitz. Cannon describes a computer-based decision support system that is used to optimize an advertising campaign (e.g., Abstract; col. 3, lines 33-38, 60-67). The preferred embodiment is described in the context of TV advertising and relies on statistical and demographic data (Nielsen data) of the TV viewing habits of a large number of persons (col. 6, line 33 et seq.).

The Cannon system includes four main components: a database; a database mining engine; an optimization mechanism; and a user interface. The database includes Nielsen TV viewing data that is placed in a very specific format that is unique to the patent (col. 14, line 8 et seq.). The user interface provides a media planner with access to the database and allows her to distribute advertisements in the media over time or space based on the data (col. 28, line 22 et seq.). The optimization mechanism incorporates a method for optimizing the scheduling or positioning of advertisements and promotions in a media environment (col. 30, line 23 et seq.).

The process of optimizing an advertising plan or schedule is an incremental one (see col. 30, line 20 et seq.). Typically, a base plan or schedule is prepared in the conventional way. Then, adjustments and modifications to the schedule are made using the optimization method of the invention. Changes to the advertising schedule are scored using factors such as exposure valuation, audience valuation, exposure recency, and cost. An example of this scoring is provided beginning at col. 38, line 65 (evaluating the effect of adding an additional airing of an advertisement to an advertising schedule already including the airing of the same advertisement in multiple spots). The proposed schedule changes are scored, and the highest score among the competing proposals indicates the schedule change that best matches the planner's media objectives.

Thus, Cannon is directed to a complex system for optimizing the scheduling of advertisements, e.g., over multiple days or weeks and over a number of media slots. Cannon has nothing to do with Applicants' invention. Even if the Cannon system were applied in the context of advertising on the Web, the most that could be said is that the system would optimize the placement of advertisements in a schedule distributed over time. Cannon is silent on whether and how to organize multiple advertisements relative to one another on a webpage, and on any criteria for making such decisions.

Further, there is no suggestion or teaching in the two references that their teachings could or should be combined in any way to result in Applicants' claimed invention. The Court of Appeals for the Federal Circuit has made it clear that such a suggestion or motivation is required to support an obviousness rejection.

> Obviousness cannot be established by combining the
> teachings of the prior art to produce the claimed invention,
> absent some teaching or suggestion supporting the
> combination. Under section 103, teachings can be
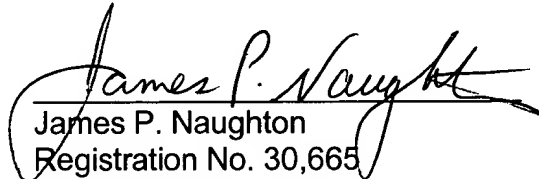> combined only if there is some suggestion or incentive to do
> so.

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ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis added). The Court of Appeals has also warned that:

> It is impermissible with the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

Bausch & Lomb, Inc. v. Barnes–Hind/Hydrocurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986) (quoting In Re Wesslaw, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965)). Since neither Markowitz nor Cannon provides the necessary suggestion or motivation to combine the references, the combination is improper and the obviousness rejection should be withdrawn.

Accordingly, Applicants respectfully submit that the present claims, and the newly added claims 67-73, patentably distinguish over the cited art, and request reconsideration and allowance of the application in view of the remarks provided above.

Respectfully submitted,

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